

USSN 10/813,206

GTI-1360-CT

REMARKS

As an initial matter, the 1 December 2004 Office action indicates that claims 1-112 are currently pending. This is incorrect. In conjunction with the filing of this continuing application on 29 March 2004, Applicants then also submitted a preliminary amendment that canceled original claims 1-47 and added new claims 48-67, several of which have been amended herein simply to use preferred and conforming punctuation and terminology. None of these amendments has been made for a reason related to patentability, and no new matter has been added. Applicants also note for the record that they reserve their rights to pursue inventive subject matter no longer or not yet claimed in this or a related application.

Applicants also wish to note that the devices claimed in this application substantively correspond to the needle-free injector/first electroporation electrode and second electroporation electrode portions of the devices specified in the method claims pending in commonly owned, co-pending application USSN 10/339,708 after entry of Applicants' amendment filed in that case on 4 May 2005.

Turning to this application, even though the Office action mistakenly referenced the claims currently pending herein, to expedite prosecution Applicants below address what they understand to be the sole remaining issue in this application, *i.e.*, the alleged obviousness of the claimed invention in view of MacLaughlin, *et al.* (U.S. patent application publication number 2002/0102729), in combination with two other U.S. patents, nos. 5,505,697 and 6,035,234. Applicants respectfully traverse, and thus they request reconsideration for the reasons discussed below.

A claimed invention is *prima facie* obvious only when the cited document or combination of documents: teaches or suggests all of the claimed elements; would motivate a person of ordinary skill in the art to modify the document(s) as suggested in the Office action; and provides a reasonable expectation of success. *See MPEP 2142, et seq.* Put

USSN 10/813,206

GTI-1360-CT

simply, the cited combination fails to suggest, let alone teach, all of the elements of the claimed invention, to wit, electroporation devices and systems that provide integrated electroporation and needle-free injection capability.

While the MacLaughlin, *et al.* patent application may discuss needle-free injection and electroporation, it does not come close to suggesting a device that provides both electroporation and needle-free injection capability, and neither the secondary nor tertiary reference compensates for these deficiencies. Moreover, there is nothing in any of the cited references that suggests modifying either the electrotransport device of the '234 patent or the electrically powered jet injector of the '697 patent to produce an electroporation device or system as claimed in the instant patent application. For these reasons Applicants respectfully submit that claims 48-67 are patentable. Accordingly, they request that the 35 U.S.C. § 103 rejection be withdrawn and that a notice of allowability issue promptly. Should any issues remain, the Examiner is encouraged to telephone applicants' undersigned attorney at 858.350.9690 so that same may promptly be resolved.

Dated: 8 DEC 2005

Respectfully submitted,

By: 
Daniel M. Chambers
Attorney for Applicants
BioTechnology Law Group
Reg. No. 34,561